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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/606,074 | 06/25/2003 | Robert S. Weiner | 04615-0100 33,213 | 4253 |
| 3490 7590 07/09/2010 DOUGLAS T. JOHNSON MILLER & MARTIN 1000 VOLUNTEER BUILDING 832 GEORGIA AVENUE CHATTANOOGA, TN 37402-2289 | | | | |
| EXAMINER DANIELS, MATTHEW J | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1791 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 07/09/2010 | | PAPER | | |

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT S. WEINER

Appeal 2009-006929
Application 10/606,074
Technology Center 1700

Before ADRIENE LEPIANE HANLON, JEFFREY T. SMITH, and
MARK NAGUMO, *Administrative Patent Judges*.

NAGUMO, *Administrative Patent Judge*.

DECISION ON APPEAL

A. Introduction¹

Robert S. Weiner (“Weiner”) timely appeals under 35 U.S.C. § 134(a) from the final rejection² of claims 1-10, 13, and 14, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6. We REVERSE.

The subject matter on appeal relates to methods of forming a decorated vinyl product suitable, for example, for covering floors and walls.

Representative Claim 1 is reproduced from the Claims Appendix to the Principal Brief on Appeal:

1. A method of creating a vinyl sheet product comprising the steps of:

depositing a design material onto a *conveyor*,

said design material in the form of one of drips, *streams*, chips and pellets deposited so as to not completely cover a top surface of the conveyor where applied;

applying a first vinyl substrate layer of a predetermined height over on the conveyor over the design to create a vinyl sheet product,

at least a portion of the design material *remaining in contact with the conveyor*; and

curing the vinyl sheet product,

wherein when the vinyl sheet product is *removed from the conveyor*,

¹ Application 10/606,074, *Embedded Vinyl Products and Method of Producing Same*, filed 25 June 2003. The specification is referred to as the “074 Specification,” and is cited as “Spec.” The real party in interest is listed as Product Concepts Residential, LLC. (Appeal Brief, filed 3 July 2008 (“Br.”), 1.)

² Office action mailed 14 February 2008 (“Final Rejection”; cited as “FR”).

the design material forming an indicia relative to the first vinyl substrate layer and inverted for use in installations with which is visible from above when installed.

(Claims App., Br. 12; indentation, paragraphing, and emphasis added.)

The Examiner has maintained the following grounds of rejection:³

A. Claims 1, 4-6, and 13 stand rejected under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103(a) in view of Weaver.⁴

B. Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Weaver, Bartlett,⁵ and Fine.⁶

C. Claims 7-9 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Weaver and Mell.⁷

D. Claim 14 stands rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Weaver and Suzuki.⁸

³ Examiner's Answer mailed 29 September 2008. ("Ans.") A rejection of claim 10 in view of Weaver and Reed (US 3,264,385) has been withdrawn. (Ans. 4.)

⁴ John B. Weaver, *Process for Producing a marbleized Plastic Sheet*, U.S. Patent 3,923,941 (1975).

⁵ Francis John Woodford Bartlett, *Method of Applying Patterns to Vinyl Floor Coverings*, U.S. Patent 2,867,263 (1959).

⁶ Jerome Fine and Gene N. Harrington, *Production of Synthetic Leather*, U.S. Patent 4,349,597 (1982).

⁷ Tod J. Mell, *Method and Apparatus for Producing a Variegated Plastic Sheet*, U.S. Patent 1,730,673 (1929).

⁸ Akihito Suzuki et al., *Flashless Rubber Floor Mat and Method*, U.S. Patent 6,589,631 B1 (8 July 2003), based on an application filed 4 October 2000.

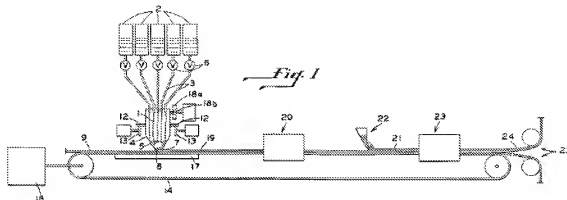
Weiner argues, *inter alia*, that the Examiner erred in finding that Weaver discloses depositing a design material in the form of “streams.” In Weiner’s view, the rolling ball applicator of Weaver does not dispense “streams” of blended plastisol design material within the scope of claim 1. (Br. 4.) Weaver argues further that claim 4-6 are allowable because those claims require that a liquid design material be deposited directly on the conveyer, whereas Weaver only shows such a deposition onto a substrate 9, which is conveyed by conveyer 14.⁹ (Br. 5.)

The Examiner responds that the recited “‘streams’ appear to be merely unbroken flows of material onto a conveyor, which are met by the Weaver process (Weaver col. 2, ll. 49-68.)” (Ans. 9.) The Examiner also argues that the substrate clearly performs the function of a conveyer. (*Id.* at 10.)

The disposition of this case depends on the correct interpretation of the terms “streams” and “conveyer,” as used in claim 1.

⁹ For clarity, labels of elements shown in figures are presented in bold font throughout this Opinion regardless of their presentation in the original document.

An apparatus described by Weaver for carrying out Weaver's process is shown in Weaver Figure I, which is reproduced below:

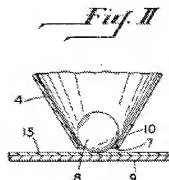


{ Weaver Figure I shows a marbled-sheet forming apparatus }

A substrate 9 is carried on belt 14 under receptacle 4, which has a circular opening 7, “which retains a rotatable, spherical, fluid-applicator 8 which may have a smooth, or a textured surface.” (Weaver, col. 2, ll. 65-68.) In Weaver’s words, “multiple *streams* of plastisol 1 are fed from supply containers 2 through conduits 3 to form a heterogeneous mixture 5.” (*Id.* at ll. 49-53; emphasis added.)

Receptacle 4 and fluid applicator 8 are shown in greater detail in Figure II, shown right:

Receptacle 4 has a hole 7 which retains rotatable spherical applicator 8. (Weaver, col. 2, ll. 65-67.) When not in contact with substrate 9, fluid-applicator rests on rim 10 of opening 7. (*Id.* at col. 2, l. 68-col. 3, l. 2.)



{ Weaver Fig. II shows the dispenser of the sheet-forming apparatus }

In operation, applicator 8 is in contact with substrate 9, and “receptacle 4 will be spaced above substrate 9 a distance sufficient to allow the applicator 8 to rotate freely in spaced relationship with the rim 10 of the opening 7.” (*Id.* at col. 3 ll. 5-9.) The spacing between receptacle 4 and substrate 9, and the spacing between applicator 8 and rim 10 of opening 7, may be varied to regulate the flow of plastisol 5 from receptacle 4. (*Id.* at ll. 15-21.) According to Weaver, plastisol 5 is a heterogeneous mixture that is “rolled onto substrate 9 by applicator 8.” (*Id.* at col. 4, ll. 32-34.)

Weiner protests that the Examiner has ascribed in the Examiner’s Answer a new meaning to the term “streams” that had not been ascribed during the preceding four or so office actions since that term was introduced. (Reply 2.) Weiner does not, however, indicate what other meaning had been ascribed. In our view, the Examiner—in a way similar to Weiner, in the Reply—merely explained the somewhat terse rejection. *Cf. In re Hyatt*, 211 F.3d 1367, 1371 (Fed. Cir. 2000) (“While the explanation given by the examiner and the Board could have been more expansive, . . . , their analysis is sufficient to apprise us of the basis on which they rejected each of the disputed claims.”) Indeed, it is difficult to see what other interpretation of the term “stream” could have been used to read claim 1 on to the process described by Weaver.

The difficulty with the Examiner’s position, however, is that the Examiner has not directed our attention to any disclosure in the supporting 074 Specification that indicates that such a broad reading of the term “streams” is described or implied. Moreover, Weaver appears to distinguish

between “streams” of plastisol, indicated by the label 1 in Weaver Figure 1, *supra*, and the plastisol that is “rolled onto substrate 9 by applicator 8” (*id.* at col. 4, ll. 32-34.) Weaver’s description of the plastisol emitted from the conduits 3 into receptacle 4 as “streams” (Weaver, col. 2, l. 49-50) is consistent with the general use of describing a material flowing without impetus other than originating pressure or gravity as a stream. The rolling applicator 8, in contrast, requires the impetus of the rotating ball to cause the plastisol to flow onto the substrate. The Examiner has not come forward with evidence of record indicating that such a flow would normally be called a “stream.” As we have already observed, the Examiner has not shown that the 074 Specification has described or implied such a flow as being a “stream.”

Moreover, as Weiner points out, most clearly in the Reply, Weaver deposits the design materials on a substrate of the prepared film, not on a conveyer. (Reply 2; *cf.* Br. 5, discussing claim 4.) The Examiner’s response, that the conveyer limitation “appears to be defined by the function of conveying, a function which item 9 of Weaver clearly does perform” (Ans. 10, ll. 1-2), is perceptive as far as it goes, but it does not go far enough. Claim 1 requires that “at least a portion of the design material remain[] in contact with the conveyer” and that the vinyl sheet product be “removed from the conveyer.” (Claims App., Br. 12.) Thus, claim 1 requires that the “conveyer” be a part of the apparatus, not a part of the vinyl sheet good produced.

The remaining rejections do not cure these deficiencies.

Accordingly, we REVERSE all the appealed rejections.

C. Order

We REVERSE the rejection of claims 1, 4-6, and 13 stand rejected under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103(a) in view of Weaver.

We REVERSE the rejection of claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Weaver, Bartlett, and Fine.

We REVERSE the rejection of claims 7-9 under 35 U.S.C. § 103(a) in view of the combined teachings of Weaver and Mell.

We REVERSE the rejection of claims 14 stands rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Weaver and Suzuki.

REVERSED

PL Initial:
sld

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